

REMARKS:**I. Introduction**

In the Office Action mailed on April 5, 2006, the Examiner rejected claims 1 to 3, 7, 8, 10 to 12, 15 and 16. The present amendment cancels no claims, amends claims 15 and 16, and adds no new claims. Accordingly, claims 1 to 12, 15, and 16 remain pending in this application.

II. Claim Rejections Based on 35 U.S.C. § 112

The Examiner rejected claim 15 under 35 U.S.C. 112, second paragraph, as indefinite. The item identified by the Examiner has been corrected. Reconsideration and withdrawal of the rejection is requested.

III. Claim Rejections Based on 35 U.S.C. § 103(a)

(a) The Examiner rejected claims 1 to 3, 7, 8, 10 to 12, and 16 under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (US 5,131,194) in view of Cross et al. (US 2,258,973):

When discussing whether the panes of Anderson are flexible enough so that the pane can be resiliently bowed in one direction for insertion of opposed edges into channels while inserting a third edge into a deeper channel so that a final edge can be inserted in to a shallower channel, the Examiner first stated that the claims are to an installation/structure, not method claims.

Features of an apparatus may be recited either structurally or functionally. Claims directed to an apparatus, however, must be distinguished from the prior art in terms of structure rather than function. MPEP 2114. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) (The absence of a disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of claimed apparatus because the limitations at issue were found to be inherent in the prior art reference).

Independent claim 1 requires the panel and the channel sections to have structures for carryout the described installation. To the extent that there are functional limitations, the

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structure must be able to perform the claimed functions. Anderson et al.'s device does not expressly disclose a structure that is able to perform the claimed functions and such is not inherent as discussed in more detail hereinbelow.

Second, the Examiner stated that Anderson et al.'s structure inherently can function to be installed as claimed by flexing and bowing per the flexibility of the window panels. In relying upon the theory of inherency, one must provide a basis in fact and/or technical reasoning reasonably to support a determination that the allegedly inherent characteristic **necessarily** will be present if the teachings of the prior art are followed. The fact that a prior art article may possibly possess the characteristics of the claimed subject matter is not sufficient to anticipate the claimed subject matter. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. **Inherency must be a necessary result and not merely a possibility.** The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) (The claims were drawn to a disposable diaper having three fastening elements. The reference disclosed two fastening elements that could perform the same function as the three fastening elements in the claims. The court construed the claims to require three separate elements and held that the reference did not disclose a separate third fastening element, either expressly or inherently.).

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic **necessarily** flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) (Applicant's invention was directed to a biaxially oriented, flexible dilation catheter balloon (a tube which expands upon inflation) used, for example, in clearing the blood vessels of heart patients). The examiner

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applied a U.S. patent to Schjeldahl which disclosed injection molding a tubular preform and then injecting air into the preform to expand it against a mold (blow molding). The reference did not directly state that the end product balloon was biaxially oriented. It did disclose that the balloon was "formed from a thin flexible inelastic, high tensile strength, biaxially oriented synthetic plastic material." *Id.* at 1462 (emphasis in original). The examiner argued that Schjeldahl's balloon was inherently biaxially oriented. The Board reversed on the basis that the examiner did not provide objective evidence or cogent technical reasoning to support the conclusion of Inherency.).

The present invention has a glazing panel that is sufficiently thin and flexible and a channel sections sized and shaped so that opposite edges of the glazing panel can be drawn together (bowed in one direction) and inserted into opposite channel sections (the left and right sides in the embodiment of figures 1 to 3) while another edge of the glazing panel (the bottom edge B of the upper panel 22A and the top edge A of the bottom panel 22B in the embodiment of figures 1 to 3) is inserted into a receiving channel (the bottom channel 30 for the upper panel 22A and the top channel 30B for the bottom panel 22B of the embodiment in figures 1 to 3). The receiving channel is deeper than the opposite channel so that the pane can be inserted into the receiving channel a sufficient depth so that the final edge (the top edge A of the upper panel 22A and the bottom edge B of the bottom panel 22B of the embodiment in figures 1 to 3) can be inserted into the channel opposite the receiving channel. The size and shape of the channels and the resilient bowing of the panel enables the panel to be inserted into and removed from the channels about the entire periphery of the pane without alteration, deformation, or disassembly of the frame.

Each pair of the Anderson et al. device is mounted within a **resiliently deflectable** elastomeric foam gasket (13). The elastomeric gasket (13) is resiliently deflected and deformed in order to install the gasket about the edges of the pane (11, 12). The pane (11, 12) may also be resiliently deflected and deformed while the gasket is installed about the edges of the pane. The specification is silent as to exactly this operation is conducted. Anderson et al. is silent as to whether the pane (11, 12) is flexible enough and the gasket (13) is sized and shaped so that the pane (11, 12) can be resiliently bowed in one direction for insertion into opposite sections of the recesses (60, 61) to allow another edge to be inserted into another channel section. While it

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may be possible that the device is so constructed, clearly this is not necessarily the case. There are many other possibilities.

Third, the Examiner stated that Anderson as modified by Cross et al. shows the deeper channel as claimed. With regard to Cross et al. the Examiner pointed out that Anderson is combined with the teaching shown in Cross et al. figure 9, not figure 2. Applicant initially points out that figures 2 and 9 of Cross et al. are to the same embodiment. Figure 2 is a horizontal cross-section and figure 9 is a vertical cross section. Thus, figures 2 and 9 clearly show that the sides of the glazing are in channels (figure 9) and the top and bottom channels are not in channels (figure 2). Cross et al. deals with inserting a relatively rigid panel in a pair of opposed channels. This is very different from the present invention and the device of Anderson et al. where the entire periphery of the panel is in channels. Even if Anderson is modified to have a deeper channel as taught by Cross et al., the modified device still does not disclose the present invention as claimed. As discussed above, Anderson et al. does not describe a glazing panel that is sufficiently thin and flexible and channel sections sized and shaped so that opposite edges of the glazing panel can be drawn together (bowed in one direction) and inserted into opposite channel sections while another edge of the glazing panel is inserted into a receiving channel. Cross et al. clearly does not fill this void because Cross et al. describes a structure for placing a rigid panel in only two opposed channel sections not channel sections about the entire periphery.

Independent claim 1, and claims dependent therefrom, are allowable because they each include the limitations of "said glazing panel being sufficiently thin and flexible to be able to be easily bowed so as to allow opposite edges of said glazing to be drawn together sufficiently to be able to be passed by the lips of opposite sections of said perimeter channel and allow another edge of said glazing panel to be received in a receiving channel section extending along said glazing opening, said receiving channel section being deeper than an opposite channel section so that upon insertion of said another edge of said glazing panel and movement towards the bottom of said receiving channel section, an edge of said glazing panel opposite said another edge clears said lip of said opposite channel section which is shallower than said receiving channel section to enable insertion and removal of said glazing panel." No prior art of

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record reasonably discloses or suggests the present invention as defined by claim 1.
Reconsideration and withdrawal of the rejection is requested.

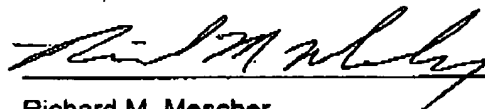
(b) The Examiner rejected dependent claim 15 under 35 U.S.C. 103(a) as being unpatentable over Anderson et al. (US 5,131,194) in view of Gasteuger (US 3,720,026).

Dependent claim 15 is allowable as depending from allowable independent claim 1 as discussed above and for novel and non-obvious matter contained therein. As discussed above, Anderson et al. does not describe a glazing panel that is sufficiently thin and flexible and channel sections sized and shaped so that opposite edges of the glazing panel can be drawn together (bowed in one direction) and inserted into opposite channel sections while another edge of the glazing panel is inserted into a receiving channel. Gasteuger clearly does not fill this void because, just like Cross et al., Gasteuger describes a structure for placing a rigid panel in only two opposed channel sections not channels sections about the entire periphery.

IV. CONCLUSION

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is found that the present amendment does not place the application in a condition for allowance, applicant's undersigned attorney requests that the examiner initiate a telephone interview to expedite prosecution of the application. If there are any fees resulting from this communication, please charge same to our Deposit Account No. 16-2326.

Respectfully submitted,



Richard M. Mescher
Reg. No. 38,242

PORTER, WRIGHT, MORRIS & ARTHUR LLP
41 South High Street
Columbus, Ohio 43215
(614) 227-2026
Fax: (614) 227-2100

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